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EXAMINER	
HOANG, HIEU T	
ART UNIT	PAPER NUMBER
2452	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/776,293	STEWART, BRETT B.	
	Examiner	Art Unit	
	HIEU T. HOANG	2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 January 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-20,23-69, 84-171, and 176-187* is/are pending in the application.

4a) Of the above claim(s) *11-20, 23-24, 92-100, 178-185, 187* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-10,25-69,84-91,101-171,176,177 and 186* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/27/2010 has been entered.

2. Claims 21, 22, 78-83, 172-175 are canceled.

3. Claims 178-187 are new.

4. Claims 1-2, 4-20, 23-69, 84-171, 176-178 are pending.

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive.

6. Applicant argues with respect to claim 1 that the prior art does not teach "the information is dependent on the demographic information of the user associated with the user identification. Examiner respectfully disagrees. Singer clearly teaches the information is dependent upon the geographic location of the at least one of the one or more access points (fig. 2 step 72, HLR sends back formatted information (col. 2 lines 39-42) based on the location information to a subscriber's device, via the access point) and based on user ID (Singer, fig. 2, step 54, PIN number identifying the user, col. 3 lines 1-5, device identifier identifying a computing device of the user; can be used for indicating the user)

7. Applicant argues that the prior art does not teach information provided to a user is associated with a business. Given the broadness of being "associated with a business," the information can be any information such as a name of a building such as "Taco Bell" and/or location such as "400 King St". In that sense, Singer does teach providing proximate building names and relative location to a user (col. 3 l. 35-42), reading on business content provided to the user.

8. Applicant argues that the prior art does not teach providing different information to different user accessing a single access point. The examiner respectfully disagrees, Singer teaches each device has a distinct ID (Singer, col. 3 lines 1-5, device identifier) that can be used to identify associated user of the device; and wherein Singer's method/system supports multiple different user subscriber device/PLU pairs using PINs and device IDs (fig. 2) and each person has his own preference for which data format, location format and proximate place names, relative position and the like, col. 3, l. 33-42, therefore information provided to each user is customized and is specific to that user or different from information provided to another user.

9. Applicant argues that the PLU and the subscriber's device receiving the PLU location information cannot be combined into one. The examiner respectfully disagrees.

10. First, the combination of the PLU and the subscriber's device does not change the principle of Singer (abstract, forwarding position information of the PLU to the device); in fact, this can still be done when the user having both the PLU and device is the one trying to locate his own position.

11. Second, Singer never teaches away from one device combination for locating one's own location because there is no disclosure, teachings and/or suggestions in Singer that would enable one of ordinary skilled in the art to conclude that Singer avoids two pieces of device to be combined into one. See In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004) [However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed…."].

12. Third, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one skilled in the art would appreciate that a person using both combination of a PLU and subscriber's device can request and receive his own location information without changing the principles of Singer.

13. Applicant argues that Singer and Muffat cannot be combined. In response to applicant's argument that, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or

all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Muffat teaches using beacons for calculating and providing routes to destination a user device (p. 930, left col., route computation using infrastructure side). Because Muffat's route computation method is beacon-based (access point position) and is done by the infrastructure and not the device, it would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Singer and Muffat to provide navigation service to a user device, such as portable devices.

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1-2, 4-20, 23-69, 84-171, 176-178 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 170, 172-173, 177-178, 180-182, 184-213 of copending Application No. 11/391,631 as of 01/22/2009 (hereafter '631). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matters in the two applications both involve identifying a client device's location at a wireless access point (WAP) (current application, claim 1 and '631, claim 170), and sending information to the client device (current application, claim 1) or advertisement related to the WAP or a brand of the WAP provider to the client device ('631, claim 170). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. Claims 1, 25, 30, 33, 43, 46, 50, 54, 55, 59, 60-63, 84, 101, 111, 127, 139, 151, 169, 170, 171, 176, 177, 186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singer et al. (US 5,485,163, hereafter Singer).

18. For claim 63, Singer discloses a method of using geographic locations of one or more access points to service one or more users who are in a vicinity of the one or more access points, the method comprising:

establishing a connection between a computing device and at least one of the one or more access points (fig. 1, abstract, access points 20, 22, 24, handheld device 6 or portable device on user 4, fig. 2, steps 64-68, col. 4, l. 19-32, signaling between personal locator unit PLU and an access point);

providing a geographic location of the at least one of the one or more access points to an information provider after said establishing (col. 4 l. 19-22, location of the base station BTS or access point is forwarded to the HLR—home location register);

receiving information from the information provider, wherein the information is dependent upon the geographic location of the at least one of the one or more access points (fig. 2 step 72, HLR sends back formatted information (col. 2 lines 39-42) based on the location information to a subscriber's device, via the access point); and a content of the information is associated with a business (col. 3 l. 41, building names or business names)

and transmitting the information to a portable computing device through said one of said one or more access points, wherein the information is transmitted to a computing device (fig. 2 step 72, HLR sends back formatted information (col. 2 lines 39-42) based on the location information to a subscriber's device, via the access point).

Singer does not disclose that the two devices are one combination or can be used as a combination on one user.

However, it would have been obvious for one skilled in the art at the time of the invention to modify the teachings of Singer to incorporate the two devices or use two devices on one user/wearer in order to provide location services to the PLU wearer so that the user can use both functionalities of the PLU and the receiving device to track his own location and/or receive location-based information.

19. For claim 43, Singer a method of providing a geographic-based information in a geographic-based communication system, wherein the geographic-based communication system uses a geographic location of a computing device operated by a user in a vicinity of a first access point of one or more access points, the method comprising:

establishing a wireless communication link between the computing device operated by the user and the first access point (fig. 1, abstract, access points 20, 22, 24, handheld device 6 or portable device on user 4, fig. 2, steps 64-68, col. 4, l. 19-32, wireless signaling between personal locator unit PLU and an access point);

determining the geographic location of the computing device and providing the geographic location of the computing device to an information provider (col. 4 l. 19-22, location of the base station BTS or access point or the PLU is forwarded to the HLR—home location register or information provider);

transmitting information from the information provider to the computing device via the wireless communication link wherein a content of the information is dependent upon the geographic location of the computing device (fig. 2 step 72, HLR sends back formatted information (col. 2 lines 39-42) based on the location information to a subscriber's device, via the access point), and is associated with a business (col. 3 l. 41, place names can be business names)

Singer does not disclose that the two devices are one combination or can be used as a combination on one user.

However, it would have been obvious for one skilled in the art at the time of the invention to modify the teachings of Singer to incorporate the two devices or use two devices on one user/wearer in order to provide location services to the PLU wearer so that the user can use both functionalities of the PLU and the receiving device to track his own location and/or receive location-based information.

20. For claim 54, Singer further discloses the computing device is a portable computing device (fig. 1, col. 4 l. 39-40, portable phone).

21. For claim 55, Singer further discloses the geographic location of the computing device comprises a geographic location of the first access point; wherein the content is dependent upon the geographic location of the first access point (col. 4 l. 19-47, fig. 2, location of the BTS and formatted location content sent to user).

22. For claim 59, Singer further discloses the geographic location of the first access point is determined by its proximity to another geographic location (fig. 2, step 70, find location of access point, col. 4 l. 19-47, proximity geographic location of a BTS, col. 4 l. 47-55, proximity to another BTS).

23. For claim 60, Singer further discloses said transmitting includes the information provider transmitting the information through a network (fig. 1, 2, HLR sends information through a network).

24. For claim 61, Singer further discloses said transmitting includes transmitting the information through the first access point (fig. 1, 2, information sent from HLR to access point).

25. For claim 62, Singer further discloses the network includes one or more of a local area network and a wide area network (fig. 1, wide area network).

26. For claim 46, Singer does not explicitly disclose said establishing includes identifying a user of the computing device; wherein the content is dependent upon said identifying the user. However, Singer discloses identifying a computing device; wherein the content is dependent upon said identifying (col. 3 lines 1-5, device identifier). It would have been obvious for one skilled in the art at the time of the invention to modify the teachings of Singer to provide content services based on user identifier instead of device ID, or can even use device ID as a user ID for providing content.

27. Claims 1 and 50 are rejected for the same rationale as in claim 46.

28. Claim 36 is rejected for the same rationale as in claim 46, further comprising: receiving a geographic location of an access point communicating with a first computing device; receiving first identification information indicating a first user of the first computing device receiving the geographic location of the access point communicating with a second computing device, wherein the second computing device is different from the first computing device receiving second identification information indicating a

second user of the second computing device, wherein the second identification is different from the first identification information, wherein the second user is different from the first user; selecting first information dependent upon the geographic location of the access point and the first identification information, wherein at least a first content of the first information is capable of being displayed by the first computing device computing device; transmitting the selected first information to the first computing device; selecting second information dependent upon the geographic location the access point and the second identification information, wherein at least a second content of the second information is capable of being displayed by the second computing device, wherein the second information is different from the first information; and transmitting the second information to the second computing device (Singer, each device has a distinct ID (Singer, col. 3 lines 1-5, device identifier) that can be used to identify associated user of the device; and wherein Singer's method/system supports multiple different user subscriber device/PLU pairs using PINs and device IDs (fig. 2) and each person has his own preference for which data format, location format and proximate place names, relative position and the like, col. 3, l. 33-42, therefore information provided to each user is customized and is specific to that user or different from information provided to another user)

29. For claims 170 and 176, Singer further discloses at least a portion of the content is capable of being displayed to a user of the computing device (Singer, col. 3 l. 32-42).

30. For claims 171 and 177, Singer further discloses the computing device is a portable computing device configured to be readily carried by a user (Singer, fig. 1, portable PLU and phone).

31. Claims 25, 30, 33, 84, 101, 111, 127, 139, 151, 169, 186 are rejected for the same rationale as in claim 36.

32. Claims 44, 45, 47-49, 51-53 rejected under 35 U.S.C. 103(a) as being unpatentable over Singer, in view of Muffat et al. (European Cooperation on Dual Mode Route Guidance-Perspectives for Advanced Research Partners, hereafter Muffat, cited in IDS).

33. For claim 44, Singer does not disclose receiving a destination; wherein the content indicates a route from the geographic location of the computing device to the destination. However, Muffat discloses using beacons for calculating and providing routes to destination a user device (p. 930, left col., route computation using infrastructure side). It would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Singer and Muffat to provide navigation service to a user device.

34. For claim 45, Singer does not disclose the content includes weather information. However, Muffat discloses the same (p. 933, fig. 3, ice on road). It would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Singer and Muffat to provide weather report service to a user device.

35. For claim 47, Singer-Muffat further discloses said identifying the user indicates a profile of the user; wherein the content is dependent on the profile of the user (Muffat, p. 930, par 5, in the first case, user profile is individual criteria, par 6, user profile is previous route computation).

36. For claim 48, Singer-Muffat further discloses said identifying the user indicates past transactions of the user; wherein the content is dependent on the past transactions of the user (Muffat, p. 930, par 5, in the first case, individual criteria or past transactions, par. 6, user past route computation).

37. For claim 49, Singer-Muffat further discloses wherein said identifying the user indicates a profile of the user; wherein the profile of the user indicates the content is desired by the user (Muffat, p. 930, par. 5 and 6, criteria desired by a user).

38. For claims 51-53, the claims are rejected for the same rationale as in claims 47-49 respectively.

39. Claims 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singer, in view of what was known in the art (Official Notice or ON).

40. For claim 56, Singer does not disclose said determining includes using a management information base (MIB), wherein the MIB comprises information including the geographic location of the first access point. Singer discloses using a lookup table (memory) for location determining (col. 4 l. 29) .However, Official Notice is taken that it was known in the art at the time of the invention to use a MIB for storing information,

including location information (see Kondo et al., US 5,586,254, fig 1C, MIB containing map location information).

It would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Singer and ON to provide services to a user device using a MIB to manage information of devices efficiently and conform to SNMP standards.

41. For claim 57, Singer-ON further discloses the access point includes a memory comprising information of the MIB, wherein the memory comprises information including the geographic location of the access point (ON, MIB, Singer, col. 4 l. 29, lookup table).

42. For claim 58, Singer-ON further discloses said determining includes the computing device querying the first access point and the first access point responding to the querying with the geographic location of the computing device; wherein said providing includes the computing device providing the geographic location of the computing device (Singer, col. 4 l. 4-47, location information sent from BTS to the device).

43. Claims 2, 4-10, 25-35, 37-42, 64-69, 84-91, 101-169, 186 contain substantially the same subject matter in claims 36, 43-63 and are therefore rejected by the same rationale. Other services including providing a map, a promotion, hotel etc. are disclosed by Muffat (fig. 3, promotions of hotels, garages, gas stations, pharmacies…)

Restrictions by Original Presentation

Claims 11-20, 23-24, 184, 185, 92-100, 178-185, 187 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 11-20, 23-24, 184, 185, 92-100, 178-185, 187 are drawn to a method for providing content to a device based on location of the access point and preference information of the user over a period of time; comprising receiving, via a first access point of the one or more access points, a geographic location of the first access point from a computing device operated by a user and communicatively coupled to the first access point. The step of receiving a geographic location of the first access point from a computing device operated by a user is not originally presented and/or distinct and not obvious over the original claim presentation, wherein geographic location of an access point is determined by a MIB (management information base) associated with the access point and not determined by or sent from a user device (see e.g. original claims 7, 8…)

Originally presented claims 1-2, 4-10, 170, 171, 25-69, 84-91, 176, 177, 101-110, 111-169, 186 are drawn to a method/system for providing content to a device based on location of the access point in communications with the device through the access point; wherein the geographic location of the access point is determined by accessing a MIB, not by a user device.

The inventions are independent or distinct because claims to the different inventions recite the mutually exclusive characteristics of such inventions. In addition, these inventions are not obvious variants of each other based on the current record.

There is an examination and search burden for these patentably distinct inventions due to their mutually exclusive characteristics. The inventions require a different field of search (e.g., searching different electronic resources, or employing different search queries); and/or the prior art applicable to one inventions would not likely be applicable to another inventions; and/or the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph (e.g., lack of support in the specification for the step of receiving geographic location of the access point from the user device).

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-20, 23-24, 184, 185, 92-100, 178-185, 187 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Conclusion

44. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Hoang whose telephone number is 571-270-1253. The examiner can normally be reached on Monday-Thursday, 8 a.m.-5 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on 571-272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HH/

Examiner, AU 2452

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452